

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why the amendments above are necessary and were not presented earlier. The amendments above are responsive to new objections and new comments made by the Examiner for the first time in the final rejection and, therefore, are necessary. Further, since this is the first substantive response to the final rejection, clearly these amendments could not have been presented earlier. Moreover, Applicants point out that the amendments above reduce issues for possible appeal by canceling claims, and making claim 10 both independent and also the main process claim. Therefore, no stringent showing under 37 CFR § 1.116(b) is even required. See, MPEP § 714.13 (II) (*“Except* where an amendment merely cancels claims, * * *, removes issues for appeal, * * * compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.”) In view of the foregoing, Applicants respectfully request that the Examiner enter and consider this amendment.

Claims 7 and 11 were objected to under 37 CFR 1.75(c) as being of improper dependent form. In response, Applicants point out that claim 7 has been canceled. With respect to claim 11, Applicants point out that the Examiner comments at the bottom of page 4 that “[claim 11] does not further limit *the limitations recited* in the [base claim 10].” First, Applicants respectfully point out that 37 CFR § 1.75(c) nowhere requires that a dependent claim limit “*the limitations recited*” in a claim from which it depends. Instead, 37 CFR § 1.75(c) only requires that a dependent claim “further [limit] *another claim.*” Second, claim 11 does, in fact, limit

even a limitation recited in claim 10. Claim 10 requires “feeding the reaction mixture to a delay structure” and “retaining the reaction mixture in the delay structure for a time * * *.” Claim 11 further limits these recited limitations of claim 10 by requiring that “the reaction mixture is pumped in circulation in a circuit in the delay structure, and a second micromixer is inserted into the circuit.” Respectfully, this objection is in error and should be reconsidered and withdrawn.

Claims 1-6, 9 and 10 were rejected under 35 USC § 103(a) as being obvious over Spikmans, *Rapid Commun. Mass Spectrometry*, 16: 1377-1388 (2002). In response, Applicants respectfully submit that the present claims are not obvious over Spikmans.

The Examiner in the second paragraph on page 6 of the final rejection misinterprets the present claims. According to the Examiner, “it is not required that the steps be performed in the same order as numbered or in any particular order, because the instant claim is drawn with the transitional phrase ‘comprising.’” Applicants respectfully submit that this is incorrect. The fact that Applicants use open-ended terminology “comprising” does not permit a shift to a different order of steps that *are expressly required to occur in a particular order*. Should the Examiner disagree, Applicants respectfully request that the Examiner cite some legal authority for this novel proposition of law. The use of the open-ended terminology “comprising” allows for additional unrecited steps to be included, but does not permit a change in the order of steps that are required to occur in a certain order.

Claim 10 requires in step a) that *a first solution* comprising the biomolecule and *a second solution* comprising the label compound be fed to *a first micromixer*.

Claim 10 step b) requires that “*said* first and second solutions in *the* first micromixer” be mixed to form *a reaction mixture*. The only antecedent basis for “said first and second solutions

in the first micromixer” are the first and second solutions fed to the first micromixer in step 10

a). Step 10 a) must clearly occur *before* step 10 b).

Claim 10 step c) requires feeding “*the* reaction mixture into *a* delay structure.” The only antecedent basis for “the reaction mixture” is the reaction mixture formed in step 10 b).

Therefore, step 10 b) must occur before step 10 c). And, since, as noted above, step 10 a) must occur before step 10 b), claim 10 clearly requires the step order a) → b) → c) so far.

Claim 10 step d) requires “retaining *the* reaction mixture in *the* delay structure.” The only antecedent basis for the reaction mixture in the delay structure is step 10 c), where the reaction mixture is fed to a delay structure. Therefore, step 10 c) must occur before step 10 d). Following the logic above, claim 10 clearly requires the step order a) → b) → c) → d).

Any other interpretation of claim 10 is clearly improper and must be discarded for the correct interpretation.

Next, the Examiner says in the third paragraph on page 6 that the claims only require feeding solutions of both compounds to a micromixer and mixing there, and “*[t]he other steps are being optional as recited.*” Clearly, this is also an incorrect interpretation as pertains to claim 10. Steps c) and d) of claim 10 are ***mandatory***, not optional.

This clearly erroneous interpretation of claim 10 must also be discarded for the correct interpretation.

When claim 10 is correctly interpreted, Applicants respectfully submit the Examiner has not made out a *prima facie* case that Spikmans would have rendered any of the present claims obvious to persons having ordinary skill in the art. Thus, the Examiner has nowhere even alleged that Spikmans teaches or suggests instant steps 10 c) and 10 d), which, as noted above, are, in

fact, *mandatory*, not optional.

According to *Manual of Patent Examining Procedure* (“MPEP”) § 2143:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest *all* the claim limitations.”

The Examiner has not made a case that Spikmans teaches or suggests all claim limitations.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

If this rejection is maintained, then Applicants respectfully request that the Examiner explain how instant steps 10 c) and 10 d) are taught or suggested by Spikmans.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/

Kurt G. Briscoe

Attorney for Applicant(s)

Reg. No. 33,141

875 Third Avenue

8th Floor

New York, New York 10022

Phone: (212) 808-0700

Fax: (212) 808-0844